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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,754

06/20/2005

Yasutomo Okajima

YAMAP0962US

3153

43076

7590

04/16/2009

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EXAMINER

LEE, LAURA MICHELLE

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

04/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/519,754	Applicant(s) OKAJIMA ET AL.	
	Examiner LAURA M. LEE	Art Unit 3724	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,2-7.
 Claim(s) withdrawn from consideration: 3,8-18,20-29.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Boyer D. Ashley/
 Supervisory Patent Examiner, Art Unit 3724

Continuation of 11. does NOT place the application in condition for allowance because: The applicant contends that the examiner rejection of claim 1 is improper for several reasons. The first reason being that one having ordinary skill in the art would have understood "that the term "bonded brittle material substrate" would mean two substrates bonded with their planar faces directed toward each other rather than edge to edge." This argument is not persuasive, especially as the applicant is arguing the claim limitations in terms of the workpiece, and as the workpiece is not being claimed. The modified device of Masakazu would be capable of cutting an edge to edge bonded material substrate, each substrate positioned under a separate cutting device, as a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. There is no language in the claims to dictate that the first and second cutting devices are opposite each other.

The applicant also contends that the first back up portion does not face the second scribing means and that the second back up portion does not face the first scribing means. However, there is nothing to prevent the sides of the cutting devices from being considered the facing direction. Even though the applicant has already provided for that the first and second cutting devices are located to face the first and second substrates respectively, there is nothing in the claim language to support that the back up portions of the two cutting devices face in the same direction as the entire cutting device. Nothing has been defined in terms of a front or facing portion of the back up portions to dictate what is considered the facing direction.

The applicant further contends that the back up portions as shown by Masakazu back up portions (guide rollers, 42) do not perform any backing up function in an edge-to-edge configuration in correspondence with the portion being scribed by the alternative cutting device. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The limitation of being in correspondence with the portion being scribed (of the alternative cutting device) does not necessitate that the back up portion is directly underneath the corresponding scribing means nor does it impart any particular structural relationship between the two. The claim limitations merely disclose that when the second scribing means is acting to scribe the second substrate, the backup portion of the first cutting device is at the same time applying pressure to the first substrate, and conversely the alternative is true, in the reverse situation of the first scribing means and second back up portion. As modified, as the Masakazu two cutting devices would be capable of operating at the same time, as shown by Fisher, and thus the backup portions would be capable of operating at the same time as the scribing means, such that it would be true that the back up portions are applying a force to their respective substrates when the corresponding scribing means are also scribing portions of their respective substrates. .